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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002525
Party	User Terra Sul Corporation a/k/a Churrascaria Boi Na Brasa
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Date	01/19/2012
Attachments	TSUL_T005eANSWER.pdf (11 pages)(920634 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Pending Application Serial No. 77/779,339
Application Filing Date: July 13, 2009
Publication Date: June 22, 2010

Boi Na Braza, Inc.,	§	
	§	
Applicant.	§	
	§	
vs.	§	Concurrent Use No. 94002525
	§	
Terra Sul Corporation a/k/a	§	
Churrascaria Boi Na Brasa,	§	
	§	
Excepted User,	§	

ANSWER

Terra Sul Corporation a/k/a Churrascaria Boi Na Brasa ("Terra Sul") for its Answer in this Concurrent Use proceeding states as follows:

1. Reference is hereby made to the allegations relating to concurrent use recited in Applicant's concurrent use application Serial No. 77/779,339 (the "Application"). Said allegations are referred to herein as "Applicant's Concurrent Use Allegation" and set forth verbatim below, with the insertion by Terra Sul of the boldface alphabetic sentence indicators to facilitate this Answer:

"(A) Applicant seeks registration of the mark in connection with "restaurant and bar services" for the entire United States, except for the State of New Jersey.

(B) Applicant is using the mark in Advertising, including print, television, radio, and web-related media, in connection with Applicant's business.

(C) Terra Sul Corp. (the "excepted user"), located at 70 Adams Street, Store No. 4, Newark, New Jersey 07105, claims to have used the mark CHURRASCARIA BOI NA BRASA in the State of New Jersey since 1996 by means of advertising for a restaurant.

(D) The excepted user has filed Applications Serial Nos. 77813335 and 77813416. Applicant's date of first use in commerce is prior to the filing date of any application filed by the excepted user (37 CFR Section 2.99(e))."

2. As to the assertions in Applicant's Concurrent Use Allegation identified herein as sentence **(A)**, Terra Sul denies that the geographic exception as claimed by Applicant, in the absence of further exceptions, conditions and limitations as to the mode or place of use of the mark, is sufficient to prevent a likelihood of confusion, mistake, or deception resulting from the use by Applicant of the mark and the use by Terra Sul of its prior adopted and used marks.

3. As to the assertions in Applicant's Concurrent Use Allegation identified herein as sentence **(B)**, Terra Sul is without knowledge or information sufficient to form a belief as to the truth of the allegations pertaining to Applicant's claim that it is using the mark in Advertising, including print, television, radio, and web-related media, in connection with Applicant's business.

4. As to the assertions in Applicant's Concurrent Use Allegation identified herein as sentence **(C)**, Terra Sul answers as follows:

- a. Terra Sul admits its company name and address.
- b. Terra Sul admits to having used the mark CHURRASCARIA BOI NA BRASA in the states of New Jersey, New York and elsewhere since 1996.

5. As to the assertions in Applicant's Concurrent Use Allegation identified herein as sentence **(D)**, Terra Sul admits it filed Trademark Applications Serial Nos. 77813335 and 77813416 on or about August 26, 2009, and that this date is later than the claimed date of Applicant's first use in commerce of the mark.

AFFIRMATIVE DEFENSES

1. Terra Sul asserts it has more extensive rights than are acknowledged in the application.

2. The geographic restriction recited in the Application is not an effective restriction due to the impossibility of enforcement of such restriction.

3. The very small direct distance of approximately six (6) miles between Newark, NJ and New York State, or nine (9) miles from Terra Sul's two Newark, NJ locations and downtown New York City (NYC), makes the recited geographic restriction ineffective and impractical. See Exhibit A.

4. Newark, NJ and NYC are part of a singular area known as the New York Metropolitan Area and cannot be divided from each other, buffered from each other, or otherwise segmented in a manner that would avoid consumer confusion.

a. The U.S. Census Bureau defines New York-Northeastern NJ as Standard Metropolitan Statistical Area (SMA) # 35620 (the New York-Northern New Jersey-Long Island SMA). Furthermore, Newark, NJ and NYC, NY are part of a wider metropolitan area often termed the "Tri-State Area" comprising southern NY including NYC, northern NJ including Newark, NJ, and southern CT.

b. NYC television and radio advertising is routinely purchased by advertisers and presented to consumers in NYC and Newark, NJ as a single, undifferentiated market.

c. Restaurant reviews and commentators in both northern NJ and southern NY routinely group restaurants in the region together as "near NYC" restaurants. See Exhibit B.

5. Terra Sul continues to advertise its restaurant services in at least the NY Metropolitan Area and the Tri-State Area.

6. Terra Sul has received recognition of its restaurant services from restaurant critics in newspapers circulating within and beyond the Tri-State Area. See Exhibit B.

7. On information an belief, Applicant has not opened a restaurant, provided restaurant services or engaged in any other business activity or expansion thereof in the New York Metropolitan Area, the Tri-State Area, the New York-Northern New Jersey-Long Island SMA or in any of the neighboring states of New York, New Jersey, Connecticut or Pennsylvania.

8. Newark, NJ and NYC are intimately connected by multiple rail, bus, automobile, ferry and other transportation links, and millions of commuters, local residents and tourists travel

the 6 miles between the two cities every day for work, shopping, dining, and various other activities, such that Applicant's mark and Terra Sul's marks cannot possible coexist in this united market.

RELIEF REQUESTED

1. Terra Sul requests that this concurrent use proceeding be determined in favor of Terra Sul and that the registration of Applicants' mark be denied.

2. Terra Sul maintains that Applicant is not a lawful concurrent user and is not entitled to registration upon the Application. In the event the Board determines that Applicant is a lawful concurrent user, Terra Sul requests that this concurrent use proceeding be determined in favor of Terra Sul and that the registration of Applicant's mark as a concurrent use registration be issued only under such further conditions and limitations as to the mode and place of use of the mark and/or the services in connection with which such mark is used as to assure that confusion, mistake, or deception is not likely to result from Applicant's concurrent use.

Date: 01/19/2012

Respectfully submitted,

/EJ Wall/
EXCEPTED USER
TERRA SUL CORPORATION a/k/a
CHURRASCARIA BOI NA BRASA
By Eamon J. Wall
Attorney-in-Charge
N.J. Bar No. NJ-2757-1994
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of “ANSWER” was served on the parties listed below, via ☐ hand delivery, ☒ first class mail, ☐ facsimile, and/or ☒ electronic mail on this 19th day of January, 2012.

Herbert J. Hammond
Justin S. Cohen
THOMPSON & KNIGHT L.L.P.
1722 Routh Street
Suite 1500
Dallas, Texas 75201

Dated: 01/29/2012

/EJ Wall/
Eamon J. Wall

APPENDIX A

1/19/12

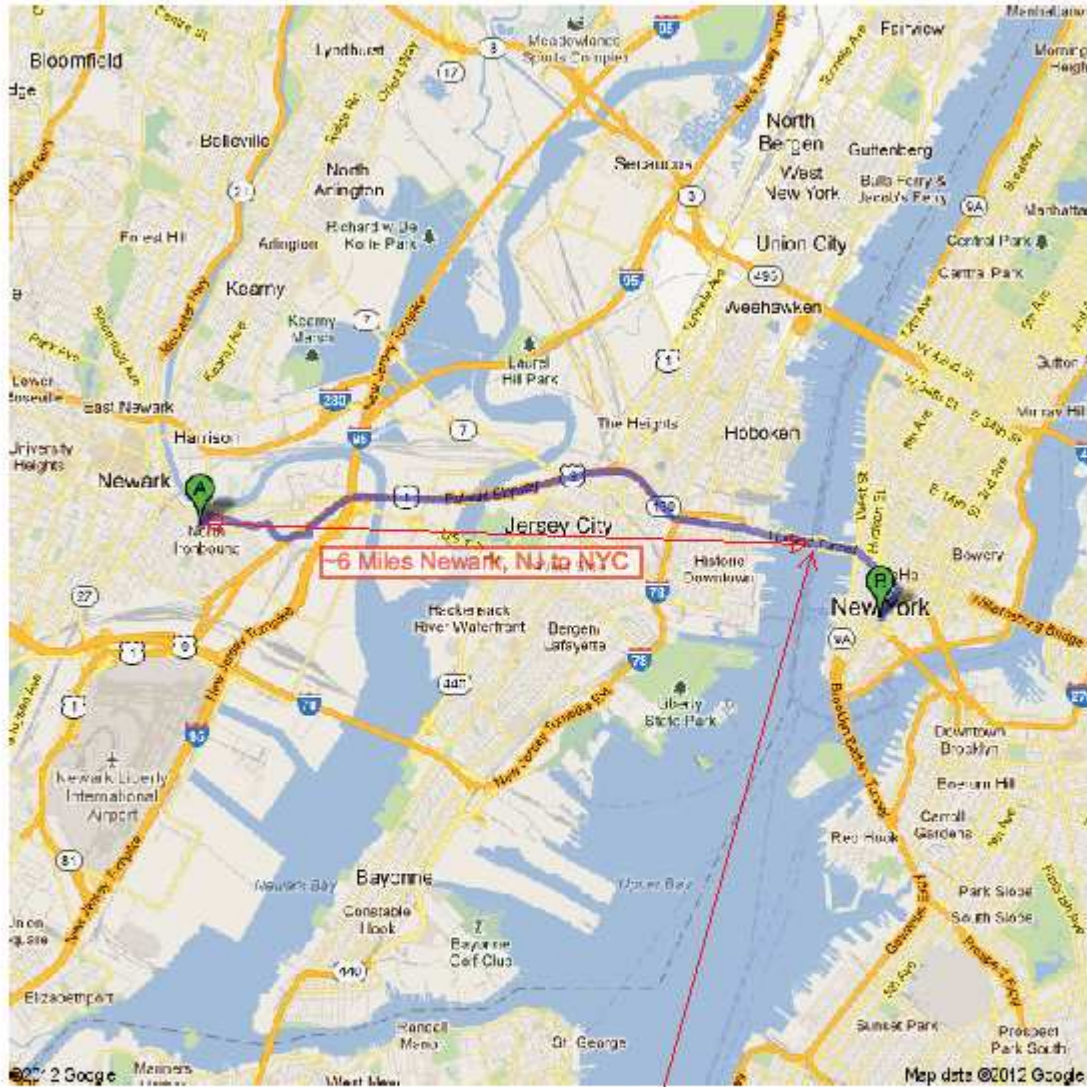
70 Adams St, Newark, NJ 07105 to New York, NY - Google Maps



Directions to New York, NY

9.7 mi – about 21 mins

Driving from Boi na Brasa to Downtown NYC



NJ/NY Border

maps.google.com/maps?f=d&source=s_d&saddr=70+Adams+Street,+Ne...

1/2

APPENDIX B

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Best choice churrascaria - 2006

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Boi Na Brasa

The all-you-can-eat meat feast called churrascaria has become commonplace around town; in fact, I even spotted one on Avenue B. Still, to save money and rub elbows with actual Brazilians one has to go to Newark's Ironbound, an easy ride on the PATH. Of the several I've reviewed there, current fave is Boi Na Brasa, off the beaten path in a strip mall decorated like a South American farmstead. The bacon-wrapped turkey is diverting, but I go right for the picanha and the blood-dripping beef rib. All meat is cooked over charcoal, and, even though there's a wine list, you can also bring your own.



Boi Na Brasa
70 Adams St.
Newark, NJ
973-589-6984
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Brazilian - 2008
[Comments \(2\)](#)

Boi na Brasa

Trek to Ironbound for churrasarias that beat the pants off the overpriced Manhattan versions. Our current fave is **Boi na Brasa** ("Bull on the Coals"), serving caramelized-surface sirloin, garlicked-chicken drumsticks, and turkey wrapped in bacon—all you can eat!



Boi na Brasa
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It's like a vacation to Brazil. Boi na Brasa ("cow on the coals") is an authentic churrasco Newark's Portuguese-speaking Ironbound, and the price alone makes it worth the trek salad bar and go right for the meat, which comes with great black beans, rice, fried yu bananas, and french fries. Thrill to the salty caramelized surface of the picanha, the goodness of the chicken drumsticks, and the bone-in bloodiness of the quarter-pound And muddle your senses with one of the strongest caipirinhas around.

Cuisine(s): [Brazilian](#), [Portuguese](#)

Payment Types: [All Major Credit Cards](#)

Reservations: [Not](#)

Hours: Sun-Wed 11:30am-2am,
Thu-Sat 11:30am-3pm

Serving: [Dinner](#), [Late Night](#),
[Lunch](#)

Parking: [No Parki](#)

Price: [\\$\\$](#)

Alcohol: [Full bar](#)

Awards

2008 | [Brazilian](#)

Trek to Ironbound for churrascarias that beat the pants off the overpriced Manhattan versions. Our current fave is Boi na Brasa ("Bull on the Coals"), serving cara sirlion, gatlicked-chicken drumsticks, and turkey wrapped ... [More >](#)

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The all-you-can-eat meat feast called churrascaria has become commonplace around town; in fact, I even spotted one on Avenue B. Still, to save money and not actual Brazilians one has to go to Newark's Ironbound, an easy ride on the... [More >](#)

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Humphless

By [Robert Sietsema](#) | Tue, March 07, 2006

Boi Na Brasa is one of a half dozen real Brazilian churrascarias to open in Newark's Ironbound in the last two years. The lure of these places